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The time period for reply, if any, is set in the attached communication.

RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAAKI YAMANAKA, HIROSHI KOYAMA and
YASUHIRO UEDA

Appeal 2009-003798
Application 08/855,905
Technology Center 1700

Oral Hearing Held: September 17, 2009

Before EDWARD C. KIMLIN, BRADLEY R. GARRIS, and CHARLES F. WARREN, *Administrative Patent Judges*.

ON BEHALF OF THE APPELLANTS:

LEO G. LENNA, ESQUIRE
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1 The above-entitled matter came on for hearing on Wednesday,
2 September 17, 2009, commencing at 1:10p.m., at the U.S. Patent and
3 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before
4 Paula Lowery, Notary Public.

5 THE CLERK: Good afternoon. Calendar Number 60,
6 Mr. Lenna.

7 JUDGE KIMLIN: Good afternoon.

8 MR. LENNA: Good afternoon.

9 JUDGE KIMLIN: Our reporter today is Paula Lowery. If you
10 have a business card for her, she'd probably appreciate it.

11 MR. LENNA: Would you like me to recite my name?

12 REPORTER: Please.

13 MR. LENNA: Leo, L-e-n-n-a.

14 JUDGE KIMLIN: You may begin. You have approximately
15 20 minutes.

16 MR. LENNA: Good afternoon, You're Honors. May it please
17 the Court; I represent the Appellants in the Application 855,905, Appeal
18 Number 2009-003798. I'd like to reserve five minutes for rebuttal.

19 This case has been up on appeal twice. I know the only
20 remaining issue is a 103(a) on three specific references. The Examiner
21 making the rejection has stated that it would be obvious to take the main
22 reference, which is Takashi reference, U.S. 950, and take out the anti-static
23 agent that's in that particular reference, which is a small amount -- less the 1
24 percent -- and replace it with an anti-static complex, which is in Ueda, which
25 is 919 European reference.

1 The Ueda reference -- I don't believe one skilled in the art
2 would look to, although it's directed to an anti-static reference. It's not
3 specifically directed to a thin-film synthetic paper anti-static agent. Instead
4 they use anti-static agents for injection molding, blow molding, and so forth.
5 The amount that Ueda teaches to use could be up to 40 percent. So with that
6 in the background, looking at the Takashi reference, which is a very simple
7 anti-static agent in a synthetic paper. It's a thin-film synthetic paper
8 between -- less than 1 percent. The Examiner attempts to use Ueda to
9 dissect the main reference, take out that anti-static agent, and add in place a
10 polyether ester amid. A specific one with aromatic rings. Those aromatic
11 rings, as shown in the application, are significant. However, they often do
12 not blend well with polypropylene, which is the base resin that is shown in
13 the Applicant's Application as well as in Takashi. Going from a simple anti-
14 static agent in Takashi, now we have a polyether ester amid with aromatic
15 rings. You have to add to that a poly amid resin. That poly amid resin
16 activate was surface orientation on the paper to make it actually work better
17 as we show.

18 In addition, because that combination is incompatible with the
19 polypropylene, you'd have to add on top of that a compatibility agent, which
20 has very specific use in the art. All with the backdrop that that's a very
21 complex composition, you're placing a very simple anti-static agent in the
22 primary reference. Also, if you look at the primary reference, the thin film --
23 it does have statements in there that it has a high level of inorganic fillers,
24 which is required for the cracking. It also has statements in there and gives a
25 concentration of the anti-static agent to be less than 1. Looking at Ueda, it

1 could be up to 40 percent of the weight of the resin -- the total weight of the
2 resin -- which there's no indication, there's no teaching that there's going to
3 be a likelihood of success. By trying to use Ueda, because it's not directed
4 to the paper field at all, in the Takashi reference, in order to arrive at the
5 Applicant's invention.

6 In addition to that, that still doesn't carry the day because we
7 require that there has to be an opaqueness of at least 83 percent. The
8 Examiner now looks to another U.S. Application 924, Ohba, and says since
9 there's a statement in there that says 80 percent of the opacity is favorable in
10 paper -- that is a paper one -- but it gives no way how to get there.

11 The Examiner says that one looking at that would alter the now
12 destructed Takashi with the complex anti-static agent from Ueda and alter it,
13 without giving any teaching on how to alter it to get an opaqueness of at
14 least 80 percent to finally arrive at the Applicant's invention. So for that
15 reason, I don't think there's a likelihood of success that one would actually
16 look to Ueda because it's not in the same art and would actually destruct
17 Takashi by taking out a simple anti-static agent and putting in this complex,
18 multi-chemical, multi-compound composition at a much higher level in
19 order to stretch this into a thin-film paper having some likelihood of success
20 with that.

21 In addition to that, just saying -- a reference says that achieving
22 80 percent opaqueness -- just saying it could be altered to do that without
23 any teaching would be to do undue experimentation in order to arrive at the
24 claimed invention.

25 JUDGE WARREN: Doesn't the primary reference have

1 opacity of -- on Table 5 and Table 7 -- of a percent -- it's in the 83 to 96
2 percent range? That's on Column 14, Table 5; and Column 16, Table 7A
3 and B.

4 MR. LENNA: I believe that's natural cellulose paper.

5 JUDGE WARREN: It's all natural cellulose paper?

6 MR. LENNA: On the bottom the way they discuss this, I
7 believe, in this reference -- it's not a synthetic. In examples specifically 8,
8 6 --

9 JUDGE WARREN: It looks to me like all polypropylene when
10 you look back at the paper-like layer on Table 2A and Table 2B.

11 Number 12, for example, in Table 3B has polypropylene, and it has an
12 opacity of 89 percent in Table 7B.

13 MR. LENNA: I don't see an anti-static agent in there on 12.

14 JUDGE WARREN: Well, still you have a reference to that. It
15 has the teaching of high opacity.

16 MR. LENNA: But not a complete teaching.

17 JUDGE WARREN: And it's your reference? It's your
18 assignee's reference?

19 MR. LENNA: It's our assignee's reference.

20 JUDGE WARREN: The reference which the Examiner cites is
21 Ohba also is assigned an application, and it has that you can achieve an
22 opacity of over 80 percent with the same kind of materials, right?

23 MR. LENNA: Yeah, the assignments were done after -- one of
24 the assignments was done after the filing of the present application. One of
25 the assignments of the Ohba was, I believe, done afterwards.

1 JUDGE WARREN: I'm not sure what difference that makes
2 right now.

3 MR. LENNA: I think the reference is in Takashi shows the
4 opacity of 80 percent.

5 JUDGE WARREN: So there must be some knowledge – in
6 any event, there's some knowledge in the art that you can achieve the
7 opaqueness in the range that's claimed without undue experimentation.

8 MR. LENNA: Yes, the Applicant's don't argue that. It's just
9 the teaching of having an anti-static agent in the polypropylene. The way
10 you're doing that is beneficial to get to the opaqueness about 83 to 89
11 percent as it's recited in the claim. You have opaqueness here that is above -
12 - I don't argue it is above the 80 percent level -- but the different
13 combinations that they're using, some without an anti-static agent, are not --
14 would not lead one to believe that the addition of the complex anti-static
15 composition of Ueda would automatically lead to opaqueness that's above 83
16 percent. There's no teaching that Ueda -- it's not a --

17 JUDGE WARREN: I'm not saying anything about Ueda. I'm
18 just talking about the references to Takashi and Ohba that show the synthetic
19 paper and show the opacity falls within range.

20 MR. LENNA: I agree Ohba does say at least 80 percent by
21 stretching the film. It gives a better writing surface. I do agree with that.
22 There's no teaching in Ohba how to actually get to that 80 percent.

23 JUDGE WARREN: Another question I have -- it may be a

1 little late, but I'll ask it anyway -- where in the Brief do you discuss the
2 chemical structure of the polyether ester amid with respect to the number of
3 benzene rings, and so forth, and compatibility?

4 MR. LENNA: I don't believe it is discussed in the Appeal
5 Brief. It is discussed in the Application. But I don't believe -- nor is the
6 Applicant contending that putting a polyether ester amid would not require a
7 poly amid. That's the invention -- that's part of the invention. I think that
8 Ueda -- again, just to restate -- could be used as stated in the Appeal Brief.
9 That it could be mostly used with injection molding and blow molding
10 because of the high concentration of the anti-static agent. One would not
11 even look for that in the paper field, and destruct such a simple anti-static
12 agent in a paper with the primary reference and include in it the polyether
13 ester amid, which would require the poly amid to give the surface cracking,
14 and also require that some kind of compatibility agent be added, specifically
15 the one that we state in the reference. For that reason I don't think it would
16 be obvious that one with skill in the art would look at that because there
17 wouldn't be any reasonable likelihood of success due to the high amount of
18 anti-static agent. This is a stretching of the thin film in a very specific art. If
19 I could also -- Ohba, when you look at that, and you look at Ueda -- both of
20 them have low amounts of anti-static agents in all of their examples. Now
21 we're talking about a reference that brings in a much higher amount. It's
22 much more complicated and requires stabilizers, requires activators, the poly
23 amid, and requires the compatibility agents. For that reason one would not
24 dissect Takashi without using the Applicant's Application as a road map and

1 using it. For that reason I think the appeal should be granted and the claims
2 allowed.

3 JUDGE KIMLIN: Any further questions?

4 JUDGE GARRIS: No.

5 JUDGE WARREN: No.

6 JUDGE KIMLIN: Thank you for coming, sir.

7 Whereupon, the proceedings at 1:26 p.m. were concluded.

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